

## **REMARKS**

In summary, claims 1-21 are pending. Claims 33, 47, and 48 were previously canceled. Claims 22-32, 34-46, and 49-73 were previously withdrawn. Claim 1 is objected to for a typographical error. Claim 1 is rejected under 35 U.S.C. § 112. Claims 1, 2, 8, 10, 12, and 21 are rejected under 35 U.S.C. § 102. Claims 3-7, 9, 11, and 13-20 are rejected under 35 U.S.C. § 103. Claim 1 is hereby amended without adding new matter. Applicants respectfully traverse the rejections. Reconsideration in view of the foregoing amendment and following remarks is respectfully requested.

### **Examiner's Response To Previous Remarks**

Applicants thank the Examiner for the instructive comments. At the urging of the Examiner, Claim 1 has been rewritten in positively recited language. This amendment, it is believed, also resolves other concerns expressed by the Examiner. Likewise, it is believed, this amendment better describes the invention over the prior art, including new grounds of rejection.

### **Objection To Claim 1 For A Typographical Error**

Claim 1 is objected to for the absence of "to" in a phrase at the end of claim 1. (Office Action, p. 4.) This typographical error has been eliminated in presently amended claim 1.

### **Rejection Of Claim 1 Under 35 U.S.C. § 112**

Claim 1 is rejected under 35 U.S.C. § 112, ¶ 2 as indefinite. Specifically, the Office Action asserts M.P.E.P. § 2172.01 to argue that claim 1 is rejected "as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. ... The omitted steps are: the steps to transform the computer instructions to perform the actions of the key, where the instructions or program do not access the cryptographic key directly." (Office Action, p. 4.) Applicants respectfully traverse the rejection, which appears to rely on an incorrect statement in M.P.E.P. § 2172.01.

If Applicants understand the argument being made, it appears the Office Action argues that Applicants cannot claim the creation of the program as an invention and, instead,

can only claim the use of the program. Applicants respectfully disagree. Further, it appears that while the Office Action asserts 35 U.S.C. § 112, ¶ 2 (indefiniteness), the argument actually falls under 35 U.S.C. § 112, ¶ 1 (written description). However, as is proven below, it doesn't matter under which paragraph the rejection is categorized because no essential step is omitted from claim 1, and claim 1 is compliant with current law.

The rejection alleging that "essential steps" are omitted from claim 1 is, in fact, an attack on the scope of the claims, i.e., a written description challenge under 35 U.S.C. § 112, ¶ 1. It is not, nor could it be, an attack under 35 U.S.C. § 112, ¶ 2 because "§ 112, ¶ 2 pertains only to claims. Agreement, or lack thereof, between the claims and the specification is properly considered only with respect to § 112, ¶ 1; it is irrelevant to compliance with § 112, ¶ 2." *Personalized Media Communications v. Int'l Trade Comm'n*, 161 F.3d 696, 706 (Fed. Cir. 1998), *quoting In re Ehrreich*, 590 F.2d 902, 906 (C.C.P.A. 1979) (emphasis added); *see also* MPEP § 2172, II (*citing In re Ehrreich*). Although, "there is a subtle relationship between the policies underlying the description and definiteness requirements, as the two standards, while complementary, approach a similar problem from different directions. Adequate description of the invention [under 35 U.S.C. § 112, ¶ 1] guards against the inventor's overreaching by insisting that he recount his invention in such detail that his future claims [subsequent to original claims] can be determined to be encompassed within his original creation. The definiteness requirement [under 35 U.S.C. § 112, ¶ 2] shapes the future conduct of persons other than the inventor, by insisting that they receive notice of the scope of the patented device." *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1560, 1561 (Fed. Cir. 1991), *citing Rengo Co. v. Molins Mach. Co.*, 657 F.2d 535, 551 (3d Cir.), *cert. denied*, 454 U.S. 1055 (1981).

"The test for definiteness [under 35 U.S.C. § 112, ¶ 2] is whether one skilled in the art would understand the bounds of the claim when read in light of the specification. **If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 [¶ 2] demands no more.**" *Miles Laboratories, Inc. v. Shandon Inc.*, 997 F.2d 870, 875-76 (Fed. Cir. 1993) (citations omitted) (emphasis added); *see also Personalized Media*, 161 F.3d 696 at 705. It is submitted that claim 1, when read in

light of the specification, reasonably apprises those skilled in the art of the scope of Applicants' invention. The Office Action has not shown that this is not the case.

Moreover, the "omitted element test" a/k/a "essential element test" is "not a correct statement of the law." *Reiffin v. Microsoft Corp.*, 214 F.3d 1342, 1347 (Fed. Cir. 2000) (Newman, J., concurring). "There is no 'essential element' test mandating an inquiry into what an inventor considers to be essential to his invention and requiring that the claims incorporate those elements." *Cooper Cameron Corp. v. Kvaerner Oilfield Prods., Inc.*, 291 F.3d 1317, 1323 (Fed.Cir.2002); *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1333 (Fed. Cir., 2003). "When the claim is supported by the patent's disclosure ..., neither law nor policy requires that the claim contain all elements described in the specification." *Reiffin*, 214 F.3d at 1348 (Newman, J., concurring).

Written description analysis [under 35 U.S.C. § 112, ¶ 1] comparing claim scope to the disclosure is only utilized to compare subsequent claims to the disclosure to determine whether the original specification, including the original claims, discloses the subsequently claimed invention. *Texas Instruments Inc. v. ITC*, 871 F.2d 1054, 1062 (Fed. Cir. 1989) ("This is the essence of the description requirement of section 112, first paragraph: whether one skilled in the art, familiar with the practice of the art at the time of the filing date, could reasonably have found the 'later' claimed invention in the specification as filed.") (emphasis added); *see also Reiffin*, 214 F.3d 1342 at 1347-48 (Newman, J., concurring); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1560, 1562 (Fed. Cir. 1991).

"The claims as filed are part of the specification, and may provide or contribute to compliance with § 112." *Hyatt v. Boone*, 146 F.3d 1348, 1352 (Fed. Cir. 1998), *cert. denied*, 525 U.S. 1141 (1999). Therefore, all originally filed claims automatically satisfy the written description requirement as a matter of law. *Vas-Cath*, 935 F.2d at 1562, *citing In re Smith*, 481 F.2d 910, 914 (C.C.P.A. 1973) ("Where the claim is an original claim, the underlying concept of insuring disclosure as of the filing date is satisfied, and the description requirement has likewise been held to be satisfied."); *see also In re Koller*, 613 F.2d 819, 823-24 (C.C.P.A. 1980) ("original claims constitute their own description. Later added claims of similar scope and wording are described thereby."); *In re Gardner*, 480 F.2d 879,

879-80 (C.C.P.A. 1973) (the original claim itself is considered an “adequate ‘written description’... whether located among the original claims or in the descriptive part of the specification”).

It is respectfully submitted that both the first and second paragraphs of 35 U.S.C. § 112 are, clearly, fully satisfied by the specification and pending claim 1. Claim 1 clearly conveys the scope of the invention to those of ordinary skill in the art, satisfying the second paragraph of 35 U.S.C. § 112. The specification, which includes claim 1, clearly describes the invention recited in claim 1, satisfying the first paragraph of 35 U.S.C. § 112. Original claims 1-21 and the remainder of the specification clearly convey what Applicants regard as an invention. Additionally, despite the erroneous statement in M.P.E.P. § 2172.01, there is no “omitted element test” a/k/a “essential element test.” Therefore, it is respectfully requested that the rejection of claim 1 under 35 U.S.C. § 112 be reconsidered and withdrawn.

**Rejection Of Claims Under 35 U.S.C. § 102**

Claims 1, 2, 8, 10, 12, and 21 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,892,899, issued to Aucsmith *et al.* (hereinafter referred to as “Aucsmith”). (Office Action, pp. 5-6.) Applicants respectfully traverse the rejection.

Aucsmith does not teach or suggest at least a “computer program . . . operable to perform said set of actions independent of a whole and any part of said cryptographic key.” Claim 1, as amended.

Contrary to the claimed invention, Aucsmith discloses distribution (i.e. partition) of decryption key and accompanying decryption program [100] into subparts [101] and “subprograms [102] that operate with the subparts, one subpart per subprogram [where] [t]he subprograms are then executed over a period of time.” Aucsmith, Summary Col. 1, ll. 35-45; see also Abstract, Col. 3, ll. 48-59. In other words, Aucsmith maintains the key, but disperses it and the program that operates on it. The program and each subprogram therein remain dependent upon the key, in whole with respect to the program and in part with respect to each subprogram within the program. Claims 1, 4, 7 and 10 confirm Aucsmith’s dependence on the

key, in whole and in part. For example, in claim 4, Aucsmith states that it discloses a “method for executing a program that operates on a secret . . . comprising . . . operating on a first subpart of the secret; and . . . operating on a second subpart of the secret.” Aucsmith, Claim 4. The Summary of Aucsmith refers to this as “distributing the secret in space as well as in time.” Aucsmith, Col. 1, l 37. The pending application identifies Aucsmith as the prior art “software that applies the key,” albeit in parts. Application, p. 1, l. 17. Although partitioning the key may be helpful, the presence of the dispersed key remains problematic for security. In contrast, the claimed invention creates a program independent of the key, in whole and in part, which may be joined with other security measures, such as those described in the pending application.

Thus, it is believed that claim 1 is allowable over Aucsmith. At least in view of their dependence on claim 1, it is similarly believed that claims 2, 8, 10, 12 and 21 are also allowable over Aucsmith. Applicants respectfully request reconsideration of claims 1-21, as amended, and withdrawal of the rejection of claims 1, 2, 8, 10, 12 and 21 as being anticipated by Aucsmith.

**Rejection Of Claims Under 35 U.S.C. § 103**

Claims 3-7, 9, 11, and 13-20 are variously rejected under 35 U.S.C. § 103(a) as being unpatentable over Aucsmith in view of one or more of the following additional references: U.S. Patent No. 6,643,775, issued to Granger *et al.* (“Granger”); U.S. Patent No. 6,715,079 issued to Maytal (“Maytal”); U.S. Patent Application Publication No. 2002/0178412 in the name of Matsui (“Matsui”); U.S. Patent No. 5,912,972, issued to Barton (“Barton”); U.S. Patent No. 6,138,236, issued to Mirov (“Mirov”) and U.S. Patent No. 5,758,293, issued to Frasier (“Frasier”). (Office Action, pp. 6-11.) Applicants traverse all rejections.

Remarks provided above with respect to rejections based on Aucsmith under 35 U.S.C. 102 apply equally to the rejections of dependent claims 3-7, 9, 11 and 13-20 under 35 U.S.C. 103. Accordingly, it is requested that the rejection of claims 3-7, 9, 11 and 13-20 under 35 U.S.C. 103 be reconsidered and withdrawn.

Amendments made herein as well as those previously made are without abandonment of subject matter. Applicant expressly reserves the right to, in the pending application or any

**DOCKET NO.:** MSFT-0188

**PATENT**

**Application No.:** 09/604,174

**Office Action Dated:** September 13, 2007

application related thereto, reintroduce any subject matter removed from the scope of claims and introduce any subject matter not present in current or previous claims.

**DOCKET NO.:** MSFT-0188  
**Application No.:** 09/604,174  
**Office Action Dated:** September 13, 2007

**PATENT**

### **CONCLUSION**

In view of the foregoing amendment and remarks, it is respectfully submitted that this application is in condition for allowance. Reconsideration of this application and an early Notice of Allowance are requested. In view of the pendency of this application for more than seven years, the Examiner is cordially invited to contact the undersigned representative of Applicants for any reason that Examiner believes may speed up allowance of the application.

Date: December 11, 2007

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